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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,214	02/22/2002	Roger D.A. Lipman	47915/A23	1358

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EXAMINER	
GHALI, ISIS A D	

ART UNIT	PAPER NUMBER
1611	

NOTIFICATION DATE	DELIVERY MODE
10/27/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/069,214	LIPMAN, ROGER D.A.	
	Examiner	Art Unit	
	Isis A. Ghali	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 August 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7,9-13,15 and 21-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5, 7, 9-13, 15, 21-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *04/21/2010*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The receipt is acknowledged of applicant's IDS filed 04/21/2010; and request for RCE filed 08/10/2010.

Claims 1-5, 7, 9-13, 15, 21-23 are pending and included in the prosecution.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/10/2010 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-5, 7, 9-13, 15, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorensen et al. (US 4,231,369, of record) in view of Kishi et al. (JP 63-280013, abstract provided by IDS filed 04/2010, and full document is currently provided).

Applicant Claims

Applicant's claim 1 is directed to a pressure-sensitive adhesive composition comprising a rubbery continuous phase with a discontinuous phase distributed therein, said discontinuous phase comprising 0.1 to 65 wt %, based on the total composition, of hydrocolloid composition comprising an uncomplexed cyclodextrin and a hydrocolloid other than cyclodextrin.

Claim 22 is directed to a pressure-sensitive adhesive composition comprising a rubbery continuous phase with a discontinuous phase distributed therein, said discontinuous phase comprising 0.1 to 65 wt %, based on the total composition, of a hydrocolloid composition consisting essentially of a cyclodextrin and a hydrocolloid other than cyclodextrin.

Determination of the Scope and Content of the Prior Art

(MPEP §2141.01)

Sorensen teaches an adhesive sealing material for use in connection to ostomy devices composed of continuous rubber phase and hydrocolloid dispersed in the continuous phase, i.e. forming discontinuous phase (abstract; col.4, lines 30-31, 55-60). Example O, Table III, shows that the styrene copolymer "Cariflex" forms 10.9% of the composition, and polyisobutylene forms 18.1 % of the composition, which read on the instantly claimed amounts because claim 4 recites up to 50% polyisobutylene and claim 5 recites up to 15% of styrene polymer. The hydrocolloid is a mixture of more than one hydrocolloid in an amount ranges from 48-56 % (col.8, lines 52-54; Example O, Table III). The composition further comprises oils, medicaments, or bactericides (col.6, lines 33, 45-47). The composition is supplied by release liner, i.e. substrate (col.9, lines 1-2).

Ascertainment of the Difference Between Scope the Prior Art and the Claims

(MPEP §2141.012)

Although Sorrensen teaches mixture of hydrocolloids, however the reference does not teach cyclodextrin among the hydrocolloids as claimed by claims 1 and 22, the amount of cyclodextrin as claimed by claims 2 and 3, or the material of the substrate as claimed in claim 15.

Kishi teaches plaster that removes body odor and stretch when skin stretches and does not cause a moist skin. The plaster comprises a base substrate layer and

adhesive layer. The adhesive layer comprises rubber adhesive such as styrene-isoprene-styrene copolymer containing ≥ 3% cyclodextrin, and more preferably ≥ 5%, and generally from 3-40% of the adhesive composition, or combination of cyclodextrin and softening agent such as guar gum, karaya gum, pectin and carboxymethyl cellulose, which are hydrocolloids other than cyclodextrin claimed by applicants. The base substrate can be polyester, which is used by applicant as backing material. (See abstract; page 4, 1st paragraph; page 5, 2nd and 3rd paragraphs; page 6; page 8, 1st paragraph). The reference does not disclose cyclodextrin as complexed, so it is uncomplexed.

Finding of Prima Facie Obviousness Rational and Motivation

(MPEP §2142-2143)

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide an adhesive composition useful for medical devices comprising continuous rubbery phase and discontinuous hydrocolloid phase comprising more than one hydrocolloid as taught by Sorensen, and replace one of the hydrocolloids in the hydrocolloid phase with 3-40% of cyclodextrin and apply the composition on a polyester substrate as taught by Kishi. One would have been motivated to do so because Kishi teaches that cyclodextrin in combination with another hydrocolloid incorporated in an adhesive composition applied on a polyester backing provides removal of body odor and stretching when skin stretches and does not cause a moist skin. One would reasonably expected formulating adhesive composition useful for

personal care and medical devices comprising continuous rubbery phase and discontinuous hydrocolloid phase comprising cyclodextrin and another hydrocolloid that effectively removes unacceptable odors and meanwhile comfortable to he user.

Regarding the claimed amounts of hydrocolloids, cyclodextrin and adhesives, the amounts taught by the prior art overlap with the instant claims. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. **See MPEP 2144.05 [R-5].**

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

5. Claims 1-5, 7, 9-13, 15, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poulsen et al. (US 4,367,732, of record) in view of Kishi et al. (JP 63-280013, abstract provided by IDS filed 04/2010, and full document is currently provided).

Applicant Claims

Applicant's claim 1 is directed to a pressure-sensitive adhesive composition comprising a rubbery continuous phase with a discontinuous phase distributed therein, said discontinuous phase comprising 0.1 to 65 wt %, based on the total composition, of

hydrocolloid composition comprising an uncomplexed cyclodextrin and a hydrocolloid other than cyclodextrin.

Claim 22 is directed to a pressure-sensitive adhesive composition comprising a rubbery continuous phase with a discontinuous phase distributed therein, said discontinuous phase comprising 0.1 to 65 wt %, based on the total composition, of a hydrocolloid composition consisting essentially of a cyclodextrin and a hydrocolloid other than cyclodextrin.

Determination of the Scope and Content of the Prior Art

(MPEP §2141.01)

Poulsen teaches a skin barrier comprises an adhesive layer comprising discontinuous hydrocolloid phase dispersed in a continuous phase comprising styrene copolymers and polyisobutylene (abstract; col.5, lines 24-26, 49; col.6, lines 35-36; col.8, lines 31-42, 62-64). The adhesive composition further comprises bacteriostatic or fungicidal agents (col.6, line 59). The hydrocolloid phase comprises at least one hydrocolloid, and forms 10-55% of the composition of the adhesive layer (col.8, lines 53-55; col.9, lines 22-23). The styrene copolymer forms 10-40% of the continuous phase (col.9, line 16). The skin barrier further comprises a non-adhesive, water impervious film secured to the adhesive layer (col.3, lines 54-56).

Ascertainment of the Difference Between Scope the Prior Art and the Claims

(MPEP §2141.012)

Although Poulsen teaches mixture of hydrocolloids, however the reference does not teach cyclodextrin among the hydrocolloids as claimed by claims 1 and 22, the amount of cyclodextrin as claimed by claims 2 and 3, or the material of the substrate as claimed in claim 15.

Kishi teaches plaster that removes body odor and stretch when skin stretches and does not cause a moist skin. The plaster comprises a base substrate layer and adhesive layer. The adhesive layer comprises rubber adhesive such as styrene-isoprene-styrene copolymer containing ≥ 3% cyclodextrin, and more preferably ≥ 5%, and generally from 3-40% of the adhesive composition, or combination of cyclodextrin and softening agent such as guar gum, karaya gum, pectin and carboxymethyl cellulose, which are hydrocolloids other than cyclodextrin claimed by applicants. The base substrate can be polyester, which is used by applicant as backing material. (See abstract; page 4, 1st paragraph; page 5, 2nd and 3rd paragraphs; page 6; page 8, 1st paragraph). The reference does not disclose cyclodextrin as complexed, so it is uncomplexed.

Finding of Prima Facie Obviousness Rational and Motivation

(MPEP §2142-2143)

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide a composition for adhesive barrier comprising continuous rubbery phase and discontinuous hydrocolloid phase comprising more than one hydrocolloid as taught by Poulsen, and replace one of the hydrocolloids in the

hydrocolloid phase with 3-40% of cyclodextrin and apply the composition on a polyester substrate as taught by Kishi. One would have been motivated to do so because Kishi teaches that cyclodextrin in combination with another hydrocolloid incorporated in an adhesive composition applied on a polyester backing provides removal of body odor and stretching when skin stretches and does not cause a moist skin. One would reasonably expected formulating adhesive composition useful for personal care and medical devices comprising continuous rubbery phase and discontinuous hydrocolloid phase comprising cyclodextrin and another hydrocolloid that effectively removes unacceptable odors and meanwhile comfortable to he user.

Regarding the claimed amounts of hydrocolloids, cyclodextrin and adhesives, the amounts taught by the prior art overlap with the instant claims. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. **See MPEP 2144.05 [R-5].**

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

6. Claims 1-5, 7, 9-13, 15, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipman (WO 99/14282, of record) in view of Kishi et al. (JP 63-280013, abstract provided by IDS filed 04/2010, and full document is currently provided).

Applicant Claims

Applicant's claim 1 is directed to a pressure-sensitive adhesive composition comprising a rubbery continuous phase with a discontinuous phase distributed therein, said discontinuous phase comprising 0.1 to 65 wt %, based on the total composition, of hydrocolloid composition comprising an uncomplexed cyclodextrin and a hydrocolloid other than cyclodextrin.

Claim 22 is directed to a pressure-sensitive adhesive composition comprising a rubbery continuous phase with a discontinuous phase distributed therein, said discontinuous phase comprising 0.1 to 65 wt %, based on the total composition, of a hydrocolloid composition consisting essentially of a cyclodextrin and a hydrocolloid other than cyclodextrin.

Determination of the Scope and Content of the Prior Art

(MPEP §2141.01)

Lipman teaches a pressure sensitive adhesive material comprising continuous phase of rubber comprising styrene copolymer and polyisobutylene; and a discontinuous phase comprising hydrocolloid (abstract). The discontinuous phase forms 15-70 wt % of the composition (page 11, first paragraph). The styrene copolymer forms 10-30 wt % of the composition, and the polyisobutylene forms 20-60 wt % of the composition (page 15, claims 1-4). Examples 1 and 2, page 13, shows that the composition comprising more than one hydrocolloid including CMC and pectin. The

composition comprises bactericides (page 11, third paragraph). The adhesive composition is coated on non-adhesive waterproof film and used in adhesive barrier or dressing for medical use (page 16, claim 13).

Ascertainment of the Difference Between Scope the Prior Art and the Claims (MPEP §2141.012)

Although Lipman teaches one or more hydrocolloids, however the reference does not teach cyclodextrin among the hydrocolloids as claimed by claims 1 and 22, the amount of cyclodextrin as claimed by claims 2 and 3, or the material of the substrate as claimed in claim 15.

Kishi teaches plaster that removes body odor and stretch when skin stretches and does not cause a moist skin. The plaster comprises a base substrate layer and adhesive layer. The adhesive layer comprises rubber adhesive such as styrene-isoprene-styrene copolymer containing ≥ 3% cyclodextrin, and more preferably ≥ 5%, and generally from 3-40% of the adhesive composition, or combination of cyclodextrin and softening agent such as guar gum, karaya gum, pectin and carboxymethyl cellulose, which are hydrocolloids other than cyclodextrin claimed by applicants. The base substrate can be polyester, which is used by applicant as backing material. (See abstract; page 4, 1st paragraph; page 5, 2nd and 3rd paragraphs; page 6; page 8, 1st paragraph). The reference does not disclose cyclodextrin as complexed, so it is uncomplexed.

Finding of Prima Facie Obviousness Rational and Motivation

(MPEP §2142-2143)

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide an adhesive barrier or dressing for medical use comprising composition comprising continuous rubbery phase and discontinuous hydrocolloid phase comprising more than one hydrocolloid as taught by Lipman, and replace one of the hydrocolloids in the hydrocolloid phase with 3-40% of cyclodextrin and apply the composition on a polyester substrate as taught by Kishi. One would have been motivated to do so because Kishi teaches that cyclodextrin in combination with another hydrocolloid incorporated in an adhesive composition applied on a polyester backing provides removal of body odor and stretching when skin stretches and does not cause a moist skin. One would reasonably expected formulating adhesive composition useful for personal care and medical devices comprising continuous rubbery phase and discontinuous hydrocolloid phase comprising cyclodextrin and another hydrocolloid that effectively removes unacceptable odors and meanwhile comfortable to he user.

Regarding the claimed amounts of hydrocolloids, cyclodextrin and adhesives, the amounts taught by the prior art overlap with the instant claims. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. **See MPEP 2144.05 [R-5].**

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the

instantly claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

7. Applicant's arguments filed 08/10/2010 have been fully considered but they are not persuasive.

> Applicant traverses the obviousness rejections above by arguing that the Examiner has not presented a prima facie case of obviousness and the statements made by the examiner are merely conclusion, not a detailed explanation; hence, the rejections are improper. The mere fact that cyclodextrin absorbs odor in some context doesn't provided a basis for combining US '628 or US '445 with the primary references. Cyclodextrin is not a typical hydrocolloid and had never previously been proposed for use in hydrocolloid-type adhesives in the thirty five years that such adhesives had been known prior to the priority date of the present application. US'369, US'732, and WO'282 list large numbers of hydrocolloids for possible use, but never mention cyclodextrins. Nor do those references suggest a need for or an advantage to be had by adding an odor-absorbent component to the adhesive itself. In US '628 and US '445, odor-absorbency is imparted to a diaper, panty liner, or similar object by providing cyclodextrin microparticles on the surfaces of the fibrous matrices of the absorbent articles. This would give no reason to suppose that cyclodextrin would exhibit such odor-absorbent properties when forming, in combination with another hydrocolloid, the discontinuous phase of a rubber-based adhesive composition.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each of US '369, US'732, and WO'282 are directed to personal care articles that contact the body and expose to body fluid. The primary references US '369, US '732, and WO '282 all teach discontinuous phase of hydrocolloid in a continuous phase of adhesive composition, as instantly claimed. The newly cited JP reference by Kishi teaches cyclodextrin in an adhesive composition along with another hydrocolloid.

In response to applicant's argument that cyclodextrin was known for long before the priority date of the present application is not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977). The discovery of a new action underlying a known process does not make it patentable. *MEHL/Biophile*, 192 F.3d at 1365, 52 U.S.P.Q.2d at 1303. Also, it is irrelevant that the prior art observers did not recognize the property or function of the disputed claim; if the prior art inherently possessed that characteristic, it anticipates. See *Verdeegal Brothers, Inc. v. Union Oil Co. of Cal.,* 814 F.2d 628, 633, 2 U.S.P.Q.2d 1051, 1054 (Fed. Cir. 1987). This is believed to be applicable here because anticipation is the epitome of obviousness. It has been held that "When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int 'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. AG Pro, Inc.,*

425 U.S. 273,282 (1976)). "When the question is whether a patent claiming the combination of elements of prior art is obvious," the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." In addition, "To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. To facilitate review, this analysis should be made explicit. But it need not seek out precise teachings directed to the challenged claim's specific subject matter, for a court can consider the inferences and creative steps a person of ordinary skill in the art would employ". Pp. 11-14. KSR INTERNATIONAL CO. v. TELEFLEXINC. ET AL. (2007). A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims as a whole would have been prima facie obvious within the meaning of 35 U.S.C. 103 (a).

> Applicant argue that the objective evidence of nonobviousness presented by the applicant rebuts the examiner's conclusion that the claims are obvious. Dr. Lipman has worked continuously with pressure-sensitive adhesives since 1965, and with hydrocolloids for over 25 years. Over the course of his professional career, Dr. Lipman has observed a long-felt need for an improved hydrocolloid-containing PSA, particularly

> an odor- absorbent PSA. The Examiner erred by ignoring this evidence. Applicant also presented evidence of an unexpected synergy that results when cyclodextrin and a second hydrocolloid are used in combination in a PSA of the sort now claimed. The striking improvement in odor absorption achieved by the invention is demonstrated in the application as filed and in Dr. Lipman's declaration. Dr. Lipman discovered that the claimed combination of cyclodextrin with another hydrocolloid in a PSA yields two unexpected advantages. First, when combined with another hydrocolloid, the cyclodextrin component exhibits strong odor-absorbing properties. Second, cyclodextrin unexpectedly enhances the adhesive properties and integrity of the composition. The Examiner asserts that Dr. Lipman does not address the individual claims of the application and that the presented "objective evidence of nonobviousness is not commensurate in scope with the claims because the claims are directed to composition, and not method of its use as odor absorbent.

In response to these arguments, applicant's attention is directed to the scope of the present claims that are directed to a composition, and all the elements of the composition are disclosed by combination of the references. The composition as claimed and the combined teachings of the references are expected to have the same properties since compounds and their properties are non-separable. Upon further review to the declaration, it is noticed that the declaration under 37 CFR 1.132 filed 09/07/2004 is insufficient to overcome the rejection of claims based upon obvious as set forth in the last Office action because: it refer(s) only to the system described in the above referenced application and not to the individual claims of the application. The declaration shows very specific composition having specific adhesives in certain amounts and also specific ranges of cyclodextrin and specific ratio between cyclodextrin and the other hydrocolloids. Further, the declaration is not directed to uncomplexed cyclodextrin as instantly claimed. Additionally, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims, because the claims are directed to composition, and not method of its use as odor absorbent.

Objective evidence relevant to the issue of obviousness may include evidence of commercial success, long-felt but unsolved needs, failure of others, and unexpected results. The evidence may be included in the specification as filed, accompany the application on filing, or be provided in a timely manner at some other point during the prosecution. The mere fact that an applicant has presented evidence does not mean that the evidence is dispositive of the issue of obviousness. See *In re Alton*, 76 F.3d 1168, 1174-75, 37 USPQ2d 1578, 1582-83 (Fed. Cir. 1996) where it is stated that to be entitled to substantial weight, the applicant should establish a nexus between the rebuttal evidence and the claimed invention, i.e., objective evidence of nonobviousness must be attributable to the claimed invention.

Further, where a valid case of prima facie obviousness has been established, the burden is shifted to applicant to demonstrate that a claimed functional property is applicable to the claim in its broad scope: *In re Greenfield*, 197 USPQ 227, 229 (CCPA 1978). (Holding that despite the fact that the rejection was one of obviousness and not anticipation, the burden was nevertheless on applicant to provide factual verification of the alleged functional property). Thus, even assuming *arguendo* that applicant has shown that a specific combination of components might exhibit unexpected property, this has not been shown for the broad genus of all ranges of combination currently claimed. In addition, regarding applicant's arguments of unexpected superior results in the instant specification, it is the examiner's position that the data in the specification regarding odor absorption are not unexpected results and therefore can not rebut prima facie obviousness. The examiner directs applicant's attention to MPEP 716.02 (a). "A

greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness...of the claims at issue." *In re Corkhill*, 711 F.2d 1496, 266 USPQ 1006 (Fed.Cir. 1985). *In Corkhill*, the claimed combination showed an additive result when a diminished result would have been expected. Furthermore, the MPEP states, "Expected beneficial results are evidence of obviousness of a claimed invention, just as unexpected results are evidence of unobviousness thereof." *In re Gershon,* 372 F.2d 535, 538, 152 USPQ 602, 604 (CCPA 1967).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IG

/Isis A Ghali/
Primary Examiner, Art Unit 1611